

REMARKS

Summary of the Office Action

In the Final Office Action, claims 15-18, 20-21, 23, 26, 28 and 31-51 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 15-18, 20-21, 23, 26, 28 and 31-51 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 15-17, 26, 32-33, 48-50 and 57 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,088,323 to Kobayashi et al. (hereinafter “Kobayashi”) in view of U.S. Patent No. 5,875,156 to Ito et al. (hereinafter “Ito”).

Claims 15-18, 21, 26, 31-37, 42-45 and 47-51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of U.S. Patent No. 4,967,286 to Nomula et al. (hereinafter “Nomula”).

Claim 56 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ito in view of U.S. Patent No. 5,967,676 to Cutler et al. (hereinafter “Cutler”).

Claims 19, 22, 24-25 and 27-30 are allowed.

Claims 20, 23, 28, 38-41 and 46 would be allowable if rewritten in independent form and to overcome the rejection under 35 U.S.C. § 112, second paragraph.

Summary of the Response to the Office Action

Applicants have amended each of the objected to dependent claims 20, 28, 38-41 and 46 to be rewritten in independent form in accordance with the Examiner's indication of allowable subject matter. As a result, claims 15, 17-18, 21 and 32-35 have been canceled without prejudice or disclaimer. Moreover, the dependencies of claims 16, 21, 26, 31, 36, 37, 42, 43, 44, and 45 have been amended in light of the above-discussed approach. Moreover, claims 47-51 have been canceled without prejudice or disclaimer.

Accordingly, claims 16, 19-20, 22-31, 36-46, and 56-57 remain pending for further consideration.

Examiner Interview on October 12, 2004

Examiner Hai Pham is thanked for the courtesies extended to the undersigned during the in-person Examiner interview held at the United States Patent and Trademark Office on October 12, 2004. The interview is summarized on the Interview Summary Form issued by the Examiner on the same day as the interview, and is discussed further below.

Rejections under 35 U.S.C. § 112, First and Second Paragraphs

In the Final Office Action, claims 15-18, 20-21, 23, 26, 28 and 31-51 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 15-18, 20-21, 23, 26, 28 and 31-51 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

With regard to the rejections under 35 U.S.C. § 112, first and second paragraphs, the Examiner confirmed during the interview that these rejections would be withdrawn if each of independent claims 15, 32, 47 and 48 were amended to place them back to their previous form before the Amendment filed on April 14, 2004. In particular, this would require deleting “surrounding annular unrecorded area” and “immediately after recording” from each of these claims and also re-introducing the “as compared to a pit-less portion” into each of these claims. The Examiner also noted this in the final sentence of the Continuation Sheet of the Interview Summary Form. While each of claims 15, 32, 47 and 48 have been canceled without prejudice or disclaimer, Applicants have proceeded with the above discussed approach regarding these particular limitations in claims 15 and 32 in the rewriting of various previously-dependent claims into independent form, as discussed below. Withdrawal of the rejections under 35 U.S.C. § 112, first and second paragraph is thus respectfully requested.

The Rejections under 35 U.S.C. §§ 102(e) and 103(a)

Claims 15-17, 26, 32-33, 48-50 and 57 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,088,323 to Kobayashi et al. (hereinafter “Kobayashi”) in view of U.S. Patent No. 5,875,156 to Ito et al. (hereinafter “Ito”). Claims 15-18, 21, 26, 31-37, 42-45 and 47-51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of U.S. Patent No. 4,967,286 to Nomula et al. (hereinafter “Nomula”). Claim 56 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ito in view of U.S. Patent No. 5,967,676 to Cutler et al. (hereinafter “Cutler”).

As indicated in the Final Office Action, 19, 22, 24-25 and 27-30 are allowed, and claims 20, 23, 28, 38-41 and 46 would be allowable if rewritten in independent form and to overcome the rejection under 35 U.S.C. § 112, second paragraph. During the interview, the Examiner noted that if the claims were amended as discussed above to obviate the rejections under 35 U.S.C. § 112, the objected to claims would be allowable if rewritten in independent form. Accordingly, in light of this indication, Applicants have opted to proceed with this approach, as discussed further below.

In particular, each of the objected to dependent claims 20, 28, 38-41 and 46 have been amended to be rewritten in independent form in accordance with the Examiner's indication of allowable subject matter. As a result, claims 15, 17-18, 21, 32-35 have been canceled without prejudice or disclaimer. Moreover, the dependencies of claims 16, 21, 26, 31, 36, 37, 42, 43, 44, and 45 have been amended in light of the above-discussed approach. Moreover, claims 47-51 have been canceled without prejudice or disclaimer. Accordingly, the outstanding rejections under 35 U.S.C. § 103(a) of claims 15-18, 21, 26, 31-37, 42-45 and 47-51 have been rendered moot in light of the foregoing discussion. Withdrawal of these rejections, as well as the claim objections, is thus respectfully requested.

Claims 56 and 57 are Now in Condition for Allowance

During the October 12, 2004 Examiner Interview, the discussion turned to a traversal of the Examiner's application of U.S. Patent No. 5,967,676 to Cutler et al. (hereinafter "Cutler") as allegedly meeting the limitations in claim 56 of an optical recording medium being "further provided with address information for recording an image pattern in said

image recording layer.” Applicants’ undersigned representative pointed to various portions of the instant specification teaching the addressing arrangements of embodiments of the instant application, including, for example, page 25, lines 1-10, and Figs. 4 and 6.

The Examiner noted that he was interpreting “further provided with address information” as being met by a teaching in Cutler of a user providing address information to be used in disc printing arrangement. Applicants’ undersigned representative reached agreement with the Examiner that specifically reciting that address information data is “embedded” in the optical disc would likely overcome Cutler, as explained by the Examiner on the Continuation Sheet of the Interview Summary Form.

Applicants’ undersigned representative then turned to claim 57. As noted at pages 6-7 of the Final Office Action, the Examiner’s position was that the “address information” feature was not being afforded patentable weight because it was recited in the preamble, but not within the body of the claim. Accordingly, Applicants’ undersigned representative suggested amending claim 57 to recite “a writing component for forming the visible image pattern at a location specified by the address information data.” The Examiner appeared to agree that this change would resolve his concerns in this regard by imparting patentable weight for the address information feature into the body of claim 57.

In light of the foregoing discussion regarding claims 56 and 57, Applicants have amended each of these claims in a manner consistent with the discussions during the Examiner Interview. Applicants respectfully submit that these claims are now in condition for allowance and withdrawal of the outstanding rejections of claims 56 and 57 is thus respectfully requested.

Conclusion

With no other rejections pending, Applicants respectfully assert that currently-pending claims 16, 19-20, 22-31, 36-46, and 56-57 are in condition for allowance for at least the foregoing reasons. It is respectfully submitted that this application should now pass to issuance. In view of the foregoing remarks, Applicants respectfully request the entry of the Amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

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By: 

Paul A. Fournier

Reg. No. 41,023

Customer No. 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Telephone: (202) 739-3000

Facsimile: (202) 739-3001